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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

DN A01157

In re application of
Barrett Richard Bobsein, et al..

Paper No.: 8

Serial No. 09/774,064

Group Art Unit: 1762

Filed: January 31, 2001

Examiner: R. Blanton

For: WATERBORNE PAPER OR PAPERBOARD COATING COMPOSITION

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

MAILED
APR 29 2002
GROUP 1700

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Sir:

This is in response to the Restriction Requirement dated March 20, 2002, in the above-identified application. Applicants respectfully request the examiner to withdraw her restriction requirement and proceed to a substantive examination of claims 1-2 at this time.

RESTRICTION REQUIREMENT

Restriction to one of the following inventions was required under 35 USC 121.

- I. Claim 1, drawn to a waterborne pigmented paper or paperboard coating composition
- II. Claim 2, drawn to a method for improving the sheet gloss of coated paper or paperboard

Applicants respectfully point out that claim 1 is directed to a waterborne pigmented paper or paperboard coating composition and claim 2 is directed to a method for improving the sheet gloss of coated paper or paperboard, the method including applying the composition of claim 1 to paper or paperboard.

The examiner argues that the two groups of claims are distinct inventions because the process can be practiced with another materially different product OR the composition may be used in a materially different process, such as air-drying the coating. The examiner also submits that have acquired a separate status in the art as shown by their different classification. Applicants respectfully traverse.

35 U.S.C. 121 states that the Commissioner may require restriction if two or more "independent and distinct" inventions are claimed in one application. Referring to the Manual of Patent Examining Procedure, Chapter 802.01, "the term "independent" (i.e. not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not usable together as disclosed or (2) process and apparatus incapable of being used in practicing the process." Applicants respectfully submit that it is not justified to make such a

requirement in the present application. Claim 1 is directed to a waterborne pigmented paper or paperboard coating composition and claim 2 is directed to a method for improving the sheet gloss of coated paper or paperboard, the claimed method including applying the composition of claim 1 and no other composition to paper or paperboard.

Thus, the criteria for two or more "independent and distinct" inventions have not been met. Moreover, as per Manual of Patent Examining Procedure chapter 803, the criteria for restriction include the necessary presence of a serious burden on the examiner if restriction is not required. Since both of these claims are concerned with closely related subject matter and particularly since claim 2 is concerned with coating the waterborne composition of claim 1, there is no such burden on the examiner. Therefore, applicants respectfully request the examiner to withdraw the restriction requirement and to proceed with a substantive examination of claims 1-2 at this time.

Applicants elect to prosecute claim 1 of Group I should the examiner make the restriction requirement final.

Applicants' agent is available in order to expedite the allowance of this case at 215-641-7822 or by FAX at 215-641-7027.

Respectfully Submitted,



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Agent for Applicants
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Date: April 17, 2002

DN A01157

CERTIFICATE OF MAILING

I hereby certify that the following correspondence is being deposited as first class mail with the United States Postal Service in an envelope addressed to the Assistant Commissioner for Patents, Washington, DC, 20231 on the date indicated next to my signature below.

Response to Restriction Requirement

DATE: April 17, 2002 SIGNATURE: Michael D. Saylor

Restriction/Election Phonecall Information
Examiner: Rebecca Blanton Phone: 703-605-4295 email: rebecca.blanton@uspto.gov

Attorney Information: (see oath & filing papers)

Name: Wendy Choi
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Case Information:

Case serial #: 09/1774-064
Attorney docket #: A 01157

Groups:

1. Cl. 1 - coating comp.
2. Cl. 2 - method of coating

With or WithOUT traverse

Spoke with: _____
Date: _____

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